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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,378	06/27/2003	Robert Keane	MPJ-D4	7979

37420 7590 08/03/2005

VISTA PRINT USA INC.
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LEXINGTON, MA 02421

EXAMINER	
GARCIA, GABRIEL I	
ART UNIT	**PAPER NUMBER**
2624	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/608,378	KEANE ET AL.	
	Examiner	Art Unit	
	Gabriel I. Garcia	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *6/27/03* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/557,571.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Gabriel Garcia

GABRIEL I. GARCIA
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/8/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Part III DETAILED ACTION

1. Claims 1-10 arte rejected under the judicially created doctrine of double patenting over claims 1,5 and 7 of U. S. Patent No. 6,650,432 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The means and detail features described in the claim 1 of the current application read on claims 1,5 and 7, of issued U.S. Patent No.. 6,650,432, the different print sizes of current application read on the individual prints print jobs having sufficiently large size jobs.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure

sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it appears not to be drawn to the claimed invention. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Katayama et al. (6,424,752).

With regard to claim 1, Katayama et al. teaches a computer-implemented method for creating an aggregate print job intended to be printed and cut to create a plurality of individual printed products (see figs 1-9), the method comprising receiving individual print jobs (e.g. fig. 3) , each individual print job

having an associated printing parameter identifying the size of printed product to be created from that individual print job (see abstract), defining a two-dimensional aggregate print job (e.g. figs. 30-32), the aggregate print job having a plurality of pre-defined individual print job locations (e.g. abstract,) arranged in each of its two dimensions, each print job location having a pre-determined size 9e.g. col. 7, lines 10-60), and assigning at least some of the received individual print jobs to individual print job locations in the aggregate print job such that the size of the product to be printed from the individual print job corresponds to the size of the assigned location in the aggregate print job (see figs. 1-9 and 11-14,17-18,25-26).

With regard to claim 2, Katayama et al. teaches each product size is one of at least two different standard product sizes and wherein the aggregate print job has individual print job locations of at least two different sizes, each location size aggregate print job being one of the at least two standard sizes (e.g. figs 4 and /or 11).

With regard to claim 3, Katayama et al. teaches wherein portion of the received individual print jobs are of a standard size and another portion of the received individual print jobs are of a second standard size and wherein individual print jobs of the first size are assigned to aggregate print locations of the first size and individual print jobs of the second size are assigned to aggregate print job locations of the second size (reads on figs. 13-14).

With regard to claim 4, Katayama et al. teaches printing aggregate print job on paper, the paper being of a sufficiently large size to accommodate the

simultaneous printing of all individual print jobs in the aggregate print job (e.g. fig. 25 and 26).

With regard to claims 6-9, the limitations of claims 6-9 are covered by the limitations of claims 1-4 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katayama et al. (6,424,752) as applied to claim 1 and/or 6 above.

With regard to claims 5 and 10, Katayama et al fails to teach cutting the paper, packaging and shipping the individual print jobs. Examiner takes official notice (MPEP 2144.03) that it is well known in the art to provide a printing system with the means to handle the delivery of a print job by using providing means for cutting, packaging and shipping the individual jobs.

Therefore, it would have been obvious to one of ordinary skill in the art to provide the system of Katayama et al with the means for handling the delivery of a print job by using providing means for cutting, packaging and shipping the individual jobs because of the following reasons: 1) will allow the system of Katayama et al.

to improve versatility by handling the printed products; and 2) by providing these means to the system of Katayama et al. will allow the user(s) to mail the final product to different costumers.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shigehiro (6,891,642) teaches an apparatus for treating images.

Connors (6,591,076) teaches a method for arrangement for improving alignment indicia in a printed image.

Peterson (6,411,742) teaches merging images to form a panoramic image.

McMillin (5,103,490) teaches a method for storing and merging optically scanned images.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (703) 872-9314.

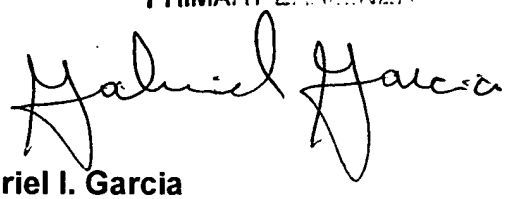
On July 15, 2005, the Central FAX Number will change to 571-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

> CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

GABRIEL GARCIA
PRIMARY EXAMINER



Gabriel I. Garcia
Primary Examiner
July 24, 2005